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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,722	04/16/2004	Russell F. McKnight	P1910US00	1771
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GATEWAY, INC. ATTN: Patent Attorney 610 GATEWAY DRIVE MAIL DROP Y-04 N. SIOUX CITY, SD 57049			EXAMINER UBER, NATHAN C	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 06/19/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/826,722

**Applicant(s)**

MCKNIGHT ET AL.

**Examiner**

NATHAN C. UBER

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3 and 10-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,3 and 10-16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the amendment filed on 8 April 2008.
2. Claim 1 has been amended.
3. Claims 10-16 have been added.
4. Claims 2 and 4-9 have been canceled.
5. Claims 1, 3 and 10-16 are currently pending and have been examined.

### **Previous Claim Rejections - 35 USC § 112**

6. Claims 1-9 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to Claims 2 and 4-9, the claims have been canceled rendering the previous rejections moot. With regard to claims 1 and 3, the rejection is withdrawn.

### **Previous Claim Rejections - 35 USC § 101**

7. Claims 1-9 were rejected under 35 U.S.C. 101 because the claimed invention was directed to non-statutory subject matter. With regard to Claims 2 and 4-9, the claims have been canceled rendering the previous rejections moot. With regard to claims 1 and 3, the rejection is withdrawn.

### **Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
10. Claims 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Garrett (U.S. 6,473,738 B1).

**Claim 10:**

Garrett, as shown, discloses the following limitations:

- *initiating a computerized transaction with the user by the merchant for a subject using the computerized transaction system* (see at least column 6, line 16-20, log-on),
- *receiving, by the computerized transaction system, from the user an indication of whether the subject of the computerized transaction is intended for use by the user or by a third party* (see at least column 3, lines 50-52, the customer indicates while shopping that an item is intended for a third party),
- *distinguishing in the computerized database system between the subject of computerized transactions by the user that is intended for use by the user and the subject of computerized transactions by the user that is intended for use by the third party* (see at least column 3, lines 50-52, the customer indicates while shopping that an item is intended for a third party),
- *presenting an offer to the user based upon the information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the user* (see at least column 7, lines 39-40 shopping list, see also Figure 5, there is no guidance in the specification defining the

contents of a user profile, examiner interprets the user profile to be a aggregation of previous purchases designated to the user not to third party recipients, further examiner broadly interprets any listing or products to constitute *an offer*, therefore a list of products organized under products purchased or to be purchased by/for the user anticipates the limitation).

**Claim 11:**

Garrett, as shown, discloses the following limitations:

- *the presenting the offer to the user is not based upon the information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the third party* (see at least column 7, lines 39-40 shopping list, see also Figure 5, there is no guidance in the specification defining the contents of a user profile, examiner interprets the user profile to be a aggregation of previous purchases designated to the user not to third party recipients, further examiner broadly interprets any listing or products to constitute *an offer*, therefore a list of products organized under products purchased or to be purchased by/for the user anticipates the limitation).

**Claim 12:**

Garrett, as shown, discloses the following limitations:

- *aggregating, in a user profile for the user in the computerized database system, information regarding the subject of computerized transactions by the user that is intended for use by the user* (see at least column 3, lines 52-53, "saving the selection list"),
- *aggregating, in the user profile for the user in the computerized database system, information regarding the subject of computerized transactions by the user that is intended for use by the third party* (see at least column 3, lines 52-53, "saving the selection list").

**Claim 13:**

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Garrett, as shown, discloses the following limitations:

- *presenting the offer to the user is based upon the aggregated information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the user* see at least column 7, lines 39-40 shopping list, see also Figure 5, there is no guidance in the specification defining the contents of a user profile, examiner interprets the user profile to be a aggregation of previous purchases designated to the user not to third party recipients, further examiner broadly interprets any listing or products to constitute *an offer*, therefore a list of products organized under products purchased or to be purchased by/for the user anticipates the limitation).

**Claim 14:**

Garrett, as shown, discloses the following limitations:

- *the presenting the offer to the user is not based upon the aggregated information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the third party* (see at least column 7, lines 39-40 shopping list, see also Figure 5, there is no guidance in the specification defining the contents of a user profile, examiner interprets the user profile to be a aggregation of previous purchases designated to the user not to third party recipients, further examiner broadly interprets any listing or products to constitute *an offer*, therefore a list of products organized under products purchased or to be purchased by/for the user anticipates the limitation).

**Claim Rejections - 35 USC § 103**

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966),

that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1, 3 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett (US 6,473,738 B1) in view of Jacobi et al. (US 7,113,917 B2).

**Claim 1:**

Garrett, as shown, discloses the following limitations:

- *determining, by the computerized transaction system, if the computerized transaction is associated with the user or on behalf of a third party* (see at least column 3, lines 50-52, the customer indicates while shopping that an item is intended for a third party),
- *aggregating, by the computerized transaction system, information associated with the transaction in a profile corresponding to the user if the computerized transaction is determined to be associated with the user* (see at least column 3, lines 52-53, "saving the selection list"),
- *aggregating, by the computerized transaction system, the information associated with the transaction in the profile corresponding to the user according to a profile distinction associated with the third party if the computerized transaction is determined to be associated with the third party* (see at least column 3, lines 52-53, "saving the selection list"),

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- *presenting, by the computerized transaction system, a product offering tailored to one or more of the user and the third party using the aggregated information associated with the transaction.*

Regarding the following limitation, Garret discloses presenting past and present product selections organized by recipient (see at least column 7, lines 39-40 shopping list, see also Figure 5) which reads on *presenting a product offering tailored to one or more of the user and the third party using the aggregated information associated with the transaction* when *product offering* is broadly construed to include a list of products. Garrett does not specifically disclose the following additional limitations, but Jacobi, as shown, does:

- *presenting, by the computerized transaction system, one or more of a special offer, a promotion, a product recommendation, and a product suggestion tailored to one or more of the user and the third party using the aggregated information associated with the transaction* (see at least column 4, lines 55-61, implementing a variety of recommendation services... generates personal recommendations),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 3:**

Garrett, as shown, discloses the following limitations:



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- *determining if the profile distinction associated with the third party is already present in the profile* (see at least column 6, line 42, the list of parties can be displayed),
- *establishing the profile distinction associated with the third party if the profile distinction is not already present in the profile* (see at least column 3, lines 46-47, generating... a list of names... the customer may associate items with),
- *aggregating the information associated with the transaction in the profile distinction associated with the third party if the profile distinction is already present in the profile* (see at least column 3, lines 52-53, "saving the selection list).

**Claim 15:**

Garrett, as shown, discloses the limitations in the rejections above. Garrett does not specifically disclose the following limitations. Jacobi, as shown, discloses the following limitation:

- *recommending a product to the user, the presentation of the offer being based upon the information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the user* (see at least column 4, lines 55-61, implementing a variety of recommendation services... generates personal recommendations),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely

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would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 16:**

Garrett, as shown, discloses the limitations in the rejections above. Garrett does not specifically disclose the following limitations. Jacobi, as shown, discloses the following limitation:

- *the recommending of the product to the user is not based upon the information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the third party (see at least column 4, lines 55-61, implementing a variety of recommendation services... generates personal recommendations),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Response to Arguments**

14. Applicant's arguments filed 08 April 2008 have been fully considered. The arguments regarding claim rejections of claims 1 and 3 under 35 U.S.C. §102 are moot in light of the above new grounds of rejection. Further the arguments regarding claim rejections under 35 U.S.C. §103 are addressed below. Applicant argues that there is no motivation to combine the applied references. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the

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teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

15. Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. Although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).
16. The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).
17. Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that: (i) obvious does not require absolute predictability; (ii) non-preferred embodiments of prior art must also be considered; and (iii) the question is not express teaching of references but what they would suggest. According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Within *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

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18. In the instant case, it appears as if the Appellant is attacking the references in a piecewise fashion, instead of in combination, as intended by the Examiner and as shown above in the rejections under 35 USC § 103(a). Examiner respectfully notes that each and every element of the application is disclosed by the prior art and when combined, as shown in the rejection, teach Applicant's invention. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex pane Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

### Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
21. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
22. Applicant may have after final arguments considered and amendments entered by filing an RCE.

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23. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
25. Any response to this action should be mailed to:

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or faxed to **571-273-8300**.

26. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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/Nathan C Uber/ Examiner, Art Unit 3622  
16 June 2008

/Arthur Duran/

Primary Examiner, Art Unit 3622

6/17/2008